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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,369	11/14/2003	David W. Andrews	014801-001600US	1857
20350	7590	04/15/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LE, THIEN MINH	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/714,369

**Applicant(s)**

ANDREWS ET AL.

**Examiner**

Thien M. Le

**Art Unit**

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

Claims 1-19 are presented for examination.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,655,587 (Andrews et al. – 6,655,587; herein after referred as "the '587 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because they essentially reciting the same limitations.

Similar to the claimed invention, claim 1 of the '587 patent recites:

1. A system for automatically loading a pre-determined value from a selectable source onto a patron's smart card, the system comprising: a central computer having a smart card data base for storing smart card data specific to the smart card; a means for initializing an autoloading flag to "on" for automatic loading of the pre-determined value onto the smart card; and a gate

device in communication with the central computer for automatically loading the smart card with the pre-determined value.

From claim 1 of the '587 patent cited above, the examiner considered the "smart card" as the claimed "fare card" since it is used with a gate device. Likewise, the examiner considers the "gate device" as the claimed "terminal device". As can be seen, that patent protections have been granted to the earlier filed application.

Similarly, claim 2 is rejected in view of claim 2 of the '587 patent in that it recites:

2. The system as in claim 1, wherein the selectable source is at least one benefit that is available to the patron through a transit customer, and wherein the central computer further comprises means for generating an autoloading list containing a value of the at least one benefit and a control number for the at least one benefit and for downloading the autoloading list to the gate device, the gate device further comprising means for comparing the control number of the at least one benefit to at least one control number on the smart card and automatically loading the smart card with the value if the control number of the autoloading list does not match the at least one control number on the smart card.

Similarly, claim 3 is rejected in view of claim 3 of the '587 patent in that it recites:

3. The system as in claim 2, wherein the autoloading flag is a benefit autoloading flag contained in the smart card data base, and wherein the means for initializing the autoloading flag to "on" is controlled by one of a transit authority, the patron, and the transit customer.

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Similarly, claims 4-8 are rejected in view of claims 4-8 of the '587 patent in that they recite:

4. The system as in claim 2, wherein the at least one benefit is a plurality of benefits, each benefit of the plurality of benefits having an associated control number.

5. The system as in claim 1, wherein the selectable source is a credit card, and wherein the autoloading flag is stored on the smart card, the gate device for loading the pre-determined value on the smart card if the autoloading flag is "on" and for communicating a force post message to the central computer after the pre-determined value is loaded onto the smart card, wherein the central computer further comprises means for determining whether at least one benefit value is available in the smart card data base to offset the pre-determined value and for processing a credit transaction for a difference between the pre-determined value and the at least one benefit value.

6. The system as in claim 5, wherein the central computer further comprises a negative list for listing smart cards in which the credit transaction is denied, the negative list for prompting the gate device to set the autoloading flag on the smart card to "off".

7. The system as in claim 5, wherein the means for initializing the smart card for automatic loading of the pre-determined value is a transit vending machine.

8. The system as in claim 7, wherein the transit vending machine utilizes at least one criterion to determine whether the patron is eligible for the automatic loading of the pre-determined value on the smart card.

Similarly, claim 9 is rejected in view of claim 10 of the '587 patent in that it recites:

10. The system as in claim 1, wherein the gate device is one of a transit system rail gate and a transit system bus fare box.

Similarly, claim 10 is rejected in view of claim 9 of the '587 patent in that it recites:

9. The system as in claim 7, wherein the transit vending machine writes credit card information onto the smart card, and wherein the force post message to the central computer comprises the credit card information.

Further, claim 10 recites the use of a smart card which thus would embrace the limitation "as least" "the mart card" of the claim.

Similarly, claims 11-14 are rejected in view of claims 11-14 of the '587 patent in that it recites:

11. A method for an automatic loading process for loading a benefits value onto a smart card, the method comprising: generating an autoloading list comprising at least one benefit available for use with the smart card, a first value for the at least one benefit, and a first control number associated with the at least one benefit; initializing the smart card with a storage area for storing an amount remaining, a second value and a second control number; reading the second value and the second control number from the smart card to a transit gate; comparing the first control number to the second control number; if the first control number is different than the second control number, adding the first value for the at least one benefit to the amount remaining and updating the amount remaining on the smart card with the result; setting the second control number equal to the first control number; setting the second value equal to the first value; and updating the first value of the autoloading list to zero if the second value is set equal to the first value; and if the first control number is the same as the second control number, terminating the automatic loading process.

12. The method of claim 11, wherein a central computer generates the autoloading list, further comprising the step of downloading the autoloading list to the transit gate.

13. The method of claim 11, wherein a partial value of the first value is added to the amount remaining, and wherein the first value of the autoloading list is updated as the difference between the first value and the partial value.

14. The method of claim 11, further comprising the step of reading the amount remaining, and if the amount remaining is above a minimum level, then terminating the automatic loading process.

Claim 15, as best understood, is rejected in view of claim 15 of the '587 patent in that it recites:

15. The method of claim 11, wherein the at least one benefit is a plurality of benefits having at least one control number and a plurality of first values associated with the at least one control number.

With regarding claim 15, since the phrase "and wherein the step of" appears incomplete, no patentable weight is given to this phrase.

Claim 16 is rejected in view of claim 16 of the '587 patent in that it recites:

16. A method for an automatic loading process for loading a pre-selected credit card value onto a smart card, the method comprising: initializing the smart card with a storage area for storing an amount remaining, credit card data, and an autoloading flag; and reading the autoloading flag; if the autoloading flag is "on", adding the pre-selected credit card value to the amount remaining on the smart card; and sending the credit card data and the pre-selected credit card value to a credit processing means, if the autoloading flag is "off", terminating the automatic loading process.

Regarding claim 17, see claim 16 of the '587 patent. Further, the smart card as recited in claim 16 of the patent would embrace the phrases "at least one of a smart card and a magnetic stripe card".

Claims 18-19 are rejected in view of claims 17-18 of the '587 patent in that they recite:

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17. The method of claim 16, wherein the credit processing means is a central computer, further comprising the steps of, determining whether patron benefits are available; if the patron benefits are available, subtracting at least a portion of the patron benefits from the pre-selected credit card value; initiating a credit process for requesting a credit transaction from a credit card processing company.

18. The method of claim 17, further comprising the step of receiving one of an approval or a denial from the credit card processing company; and if the denial is received, adding the smart card to a negative list, wherein the negative list is utilized to set the autoload flag to "off".

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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A handwritten signature in black ink, appearing to be 'Le, Thien Minh', written in a cursive style.

**Le, Thien Minh**  
**Primary Examiner**  
**Art Unit 2876**  
**March 22, 2005**